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REMARKS

Upon receipt of this response, the Examiner is respectfully requested to contact the undersigned representative of the Applicant to arrange a telephone interview concerning the inventive merits of this application.

Please enter the following before reconsideration of this application.

Claims 23-32 and 34-36 are present pending in the Application and claims 23-32 and 34-36 are rejected, under 35 U.S.C. § 102(b), over Hawarden et al. '474 (U.S. Patent No. 6,231,474). The Applicant acknowledges and respectfully traverses the raised anticipatory rejection in view of the following remarks.

The Applicant respectfully disagrees with the Examiner's interpretation of Hawarden et al. '474 and the application of the teachings of Hawarden et al. '474 with respect to the present invention as recited in claims 23-32 and 34-36. In particular, first considering the present invention, as recited in independent claims 23, 34 and 36, it will be noted that after a review of the claims, the Applicant slightly revise claims 23, 34 and 35 to clarify the grammar thereof and thereby the invention as recited in the claims. It will also be noted that these amendments are fully supported by the specification and claims as originally filed and do not add any new matter to the present invention, the specification or the claims and are not submitted in order to further distinguished over the teachings of the cited prior art.

As recited in claim 23, the present invention is directed to a method for operating an automatic transmission of a motor vehicle when the transmission is in a coasting mode and in anticipation of the driver's desires upon exiting the coasting mode and, in particular, to a method for executing downshifts in an automatic clutch, when the transmission is in the coasting mode. The method of claim 23, for executing automatic transmission downshifts when the transmission is in a coasting mode, includes the steps of: (a) performing a first downshifting operation during a coasting mode, that is, while a clutch located between the vehicle drive motor and the transmission is disengaged, and either: (b) terminating the first downshifting operation by engagement of the clutch or, (c) if the speed of the vehicle falls below a predetermined threshold speed, (c1) performing a second downshifting operation by downshifting at least two gears without re-engaging the clutch, and (c2) terminating the second downshifting operation by engaging the clutch located between the vehicle drive motor and the transmission.

A perusal of independent claims 34 and 36 reveals that those claims are based upon and contain essentially the same recitations and limitations as claim 23, but include further recitations further detailing the operational steps of the method of claim 23, such as specifically

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reciting the steps of engaging and disengaging the clutch during the execution of the method, applying compression braking while the clutch is engaged, and so on. The following discussion will focus, however, on the invention as recited in claim 23 since the recitations and limitations therein are essentially common among independent claims 23, 34 and 36 and are thereby incorporated into the dependent claims by virtue of dependency.

Turning now to the teaching of Hawarden et al. '474, this reference relates to and describes a method for controlling the engine speed at which an automatic transmission performs downshifts according to the driver's operation of the engine brake, that is, the use of engine compression as a brake *when the engine to transmission clutch is engaged*, or the combination of the engine brake and the foot brake.

In view of the above, it is apparent that there are a number of fundamental and patentable distinctions between the present invention, as recited in claims 23, 34 and 36 as well as the associated dependent claims, and the teachings of Hawarden et al. '474. For example, the method of Hawarden et al. '474 determines the engine speed at which the transmission may perform a downshift according to whether the driver is using engine braking or engine braking in combination with the foot brake. According to the method of the present invention, however, and in complete contrast from Hawarden et al. '474, the downshift speeds are not variables but are instead fixed values and the variable factor is whether or not a downshift is to be performed.

In yet further fundamental distinction between the present invention and Hawarden et al. '474, the method of Hawarden et al. '474 determines the downshift speed, as a function of the engine speed, and whether the driver is using engine braking or the combination of engine braking with foot braking. In distinct contrast, according to the present invention, the determination of whether or not a downshift is executed is a function of not only the vehicle speed but whether or not the clutch, located between the engine and the transmission, is engaged or not engaged, that is, whether or not the transmission is in a coasting mode or not in a coasting mode. The present invention is, therefore, fully independent of engine braking and foot braking while Hawarden et al. '474 does not even mention or consider whether the engine and transmission are in a coasting mode or consider the operating status of the clutch located between the engine and the transmission.

In addition, the presently claimed invention is further fully distinguished over and from the teachings of Hawarden et al. '474 because the method of the present invention requires that *the engine and the transmission be in the coasting mode before a downshift can occur*, that is, that the clutch located between the engine and transmission must be disengaged before a

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down shift can occur. Stated another way, in the coasting mode according to the present invention, the clutch is disengaged unless, and only unless, the vehicle is accelerating, at which point the clutch is engaged to allow the vehicle to accelerate.

In contrast from the present invention, however, the Hawarden et al. '474 method allows a downshift when the driver is either using engine braking or engine braking in combination with the foot brake, which requires that the clutch located between the engine and transmission be engaged during the period immediately before a downshift. The Hawarden et al. '474 method, therefore, is either accelerating or engine braking and does not even contemplate a coasting mode per se, let alone a coasting mode according to the present invention in which the clutch is disengaged *unless* the vehicle accelerating and, as a consequence of the disengaged clutch, engine braking is not available.

It is therefore the Applicant's belief and position that, for the reasons discussed above, the presently claimed invention is fully and patentably distinguished over and from the teachings of Hawarden et al. '474 under the requirements and provisions of either 35 U.S.C. 102 and/or 35 U.S.C. 103. It is further the Applicant's belief and position that since claims 24-32 and 34 depend from claim 23 and because claim 35 depend from claim 34, claims 24-32 and 34 incorporate all recitations and limitations of claims 23 and 34 and are thereby fully and patentably distinguished over and from the teachings of Hawarden et al. '474 under the requirements and provisions of 35 U.S.C. 102 and/or 35 U.S.C. 103 for the reasons discussed above. The Applicant accordingly respectfully requests that the Examiner reconsider and withdraw all rejections of claims 23-32 and 34-36, over the cited art of Hawarden et al. '474, and allow claims 23-32 and 34-36 as amended herein above.

If any further amendment to this application is believed necessary to advance prosecution and place this case in allowable form, the Examiner is courteously solicited to contact the undersigned representative of the Applicant to discuss the same.

In view of the above amendments and remarks, it is respectfully submitted that all of the raised rejection(s) should be withdrawn at this time. If the Examiner disagrees with the Applicant's view concerning the withdrawal of the outstanding rejection(s) or applicability of the Hawarden et al. '474 reference, the Applicant respectfully requests the Examiner to indicate the specific passage or passages, or the drawing or drawings, which contain the necessary teaching, suggestion and/or disclosure required by case law. As such teaching, suggestion and/or disclosure is not present in the applied references, the raised rejection should be withdrawn at this time. Alternatively, if the Examiner is relying on his/her expertise in this field, the Applicant respectfully requests the Examiner to enter an affidavit substantiating the

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Examiner's position so that suitable contradictory evidence can be entered in this case by the Applicant.

In view of the foregoing, it is respectfully submitted that the raised rejection(s) should be withdrawn and this application is now placed in a condition for allowance. Action to that end, in the form of an early Notice of Allowance, is courteously solicited by the Applicant at this time.

The Applicant respectfully requests that any outstanding objection(s) or requirement(s), as to the form of this application, be held in abeyance until allowable subject matter is indicated for this case.

In the event that there are any fee deficiencies or additional fees are payable, please charge the same or credit any overpayment to our Deposit Account (Account No. 04-0213).

Respectfully submitted,


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